Claims 6-11 were rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 4,025,709 of Blaise *et al.* (Blaise). The Office Action stated that Blaise teaches the use of 2.4, 1.2 and 0.6 g of fluorinated emulsifier into two liters of water and a latex containing 35% solids, and that the emulsifier can be the sodium salt of perfluorooctanoic acid.

The Official Action continued that the particle size is inherent in the process and composition. In the alternative, the Official Action stated that using the ammonium salt of an acid instead of the sodium salt is obvious, if better solubility water is desired and so is adding a colorant to the composition.

Applicant respectfully submits that the teachings of Blaise do not disclose or suggest the invention as set forth in the present claims within the meaning of 35 U.S.C. § 102 or 35 U.S.C. § 103.

Applicant is attaching hereto a 37 C.F.R. § 1.132 of Mr. Nobuhiko Tsuda (Tsuda declaration). In this declaration, the procedures in Examples 7 of the Blaise were repeated, and it was determined that the polymer particle size in the resulting dispersion was 278 nm, which is outside the scope of applicant's claims, namely, not more than 200 nm. The Tsuda declaration establishes that the dispersion proposed by Blaise cannot, in fact, have the presently claimed particle size. The Official Action acknowledged that the teachings of Blaise do not disclose or suggest the present claimed particle size, but took the position

that the presently claimed particle size is inherent in the teachings. The Tsuda declaration establishes that the dispersion proposed by Blaise cannot have the presently claimed particle size. Thus, the teachings of Blaise cannot contemplate or suggest an aqueous dispersion of a vinylidene fluoride polymer which comprises a vinylidene fluoride polymer having an average particle size of not more than 200 nm and a surfactant, wherein a solid content is from 30 to 50 % by weight, a content of the surfactant is not more than 1% by weight on the basis of water, *inter alia*, as required by the present claims.

While the Official Action stated that the emulsifier of Blaise can be the sodium salt of perfluorooctanonic acid, which is used in the examples of Blaise, applicant respectfully submits that this is not quite correct. The examples of Blaise use a sodium salt of a flourine-containing sulfonic acid. Accordingly, the teachings of Blaise do not contemplate or suggest the specific flourine-containing acid as set forth in Claims 7, 10, and 11. Furthermore, applicant respectfully submits that position set forth in the outstanding Office Action concerning the substitution of ammonium salt for a sodium salt is not pertinent in the present situation, because the teachings of Blaise propose a sodium salt of a flourine-containing sulfonic acid. Accordingly, if an ammonium salt was substituted into the teachings of Blaise, the result would be the ammonium salt of a flourine-containing sulfonic acid, which does not contemplate or suggest the flourine-containing surfactant as set forth in

applicant's Claims 7, 10, and 11. Therefore, applicant respectfully submits that these claims are distinguishable from the teachings of Blaise.

The applicant is unable to find any discussion in the teachings of Blaise concerning a method for preparing a paint composition, as required in Claims 9-11. The teachings of Blaise are concerned with preparing a thermally stable molding product having less coloration and, thus, the polymer obtained from the teachings of Blaise is isolated from molding. For this reason, it is desirable that the particles have a large size, so they can easily be separated by sedimentation. However, such a molding product is not desirable in the paint composition, such as set forth in applicant's Claims 9-11, because it is desired that the polymer particles be homogeneously dispersed throughout the dispersion in a paint composition, as set forth in these claims. Therefore, applicant respectfully submits that the teachings of Blaise cannot contemplate or suggest the invention as set forth in Claims 9-11. Therefore, applicant respectfully submits that these claims are distinguishable from the teachings of Blaise.

In addition to the above, attention is again directed to the remarks set forth in the Preliminary Amendment filed January 17, 2001, at pages 7-9, which further explain why the teachings of Blaise cannot disclose or suggest the presently claimed invention.

For all these reasons, applicant respectfully requests that the Examiner reconsider and withdraw the rejection of the present claims over the teachings of Blaise.

With the prior art rejection out of the way, the only remaining rejections are the two rejections of Claim 6-11 under 35 USC 112, first paragraph. Applicant respectfully submits that the positions set forth in these rejections misquote applicant's specification by quoting language out of context. Applicant also respectfully submits that the positions set forth in these rejections are incorrect.

In the first rejection under 35 U.S.C. § 112, first paragraph, the Official Action sets forth three quotes from applicant's specification. Applicant respectfully submits that the first is taken out of context and that the complete quote does not support the positions raised the outstanding Office Action. Below, the first quote as set forth the outstanding Office Action is set forth together with additional text surrounding the quote, which additional text is necessary for a proper understanding of the quote in question. In the following quotes, the additional text is set forth in italics.

> *Usually, the particle size of the latex tends to increase together with a polymer concentration, and* when the fluorine-containing surfactant is use only and if its amount is not more than 1 % by weight, there cannot be obtained a particle size of not more than 200 nm if the solid content is assumed to be 30 to 50 % by weight.

The key word is "usually." This word in conjunction with the remaining portion of this sentence means that *usually* if the amount of the fluorine-containing surfactant is not more than 1% by weight, there cannot be obtained a particle size of not more than 200nm, if the solid content is assumed to be 30 to 50% by weight. Usually does not mean always, thus, Claim 6 is consistent with this sentence in that the particle size could be not more than 200 nm if the amount of the fluorine-containing surfactant is not more than 1% by weight.

The third quote set forth in the Official Action reads as follows:

> In order to prepare the aqueous dispersion which comprises the VdF polymer having a particle size of not more than 200 nm and contains solids in the amount of 30 to 50% by weight, it is *usually* necessary to use a large amount of fluorine containing surfactant. However, according to the preparation process of the present invention, it is possible to decrease the amount of fluorine-containing surfactant to a small amount not more than 1% by weight by adding a trace amount of nonionic non-fluorine-containing surfactant. Namely, a small particle size of not more than 200 nm can be obtained by adding the nonionic non-fluorine-containing surfactant. (Emphasis added.)

Here, the key words are "usually" and "possible." Simply because applicant's specification says that something is "usual" does not mean that it is impossible or not within the scope of the invention to decrease the amount of fluorine-containing surfactant to a small amount of not more than 1% by weight without the addition of any nonionic non-flourine-containing surfactant

and still obtained a particle size of not more than 200 nm. Unusual does not mean not enabled. The word "possible" is discussed below.

The second quote set forth in the Official Action reads as follows:

> It is *possible* in the present invention that into the known emulsion polymerization system, notwithstanding that the solid content is as high as 30 to 50% by weight, the particle size can be decreased to not more than 200 nm by adding a nonionic non-fluorine-containing surfactant in a trace amount of 0.001 to 0.1% by weight on the basis of water in the presence of a small amount of the fluorine-containing surfactant, i.e. not more than 1% by weight, on the basis of water. (Emphasis added.)

The key word here is "possible." Simply because something is possible does not mean that something else is not possible. In other words, while it may be possible that the present invention can obtain a decrease in particle size to not more than 200 nm with a solid content as high as 30 to 50% by the addition of a nonionic non-flourine-containing surfactant in a trace amount of 0.001 to 0.1% by weight on the basis of water in the presence of a small amount of fluorine-containing surfactant (not more than 1% by weight) on the basis of water, does not mean that it is not possible within the scope of the invention to obtain the same solid content and particle size without the addition of the nonionic non-flourine-containing surfactant.

Applicant further respectfully submits that the present specification both enables and provides an appropriate written description of the invention as set forth in Claims 6-11 within the meaning of the first paragraph of 35 U.S.C. § 112. Applicant's specification at page 3, line 34, through page 4, line 4, and

page 4, line 7-12, describes a dispersion using only a fluorine-containing surfactant in the amount of not more than 1% by weight on the basis of water, thereby providing a written description of the invention that corresponds to Claim 6.

In order to comply with 35 U.S.C. § 112, first paragraph, all that is required is that the application reasonably conveys to persons skilled in the art that, as of the filing date thereof, the inventor had possession of the subject matter later claimed by him. *In re Lukach*, 169 USPQ 795 (CCPA 1971); *In re Edwards*, 196 USPQ 465 (CCPA 1975). The basic premise is that the test for determining whether the disclosure complies with the description of the invention requirement is whether it would have reasonably conveyed to one of ordinary skill in the art that the inventor invented the later-claimed subject matter. *In re Kaslow*, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The invention claimed does not have to be described *ipsis verbis* (in the identical words) in order to satisfy the description requirement the first paragraph of Section 112. *Martin v. Johnson*, 172 USPQ 391, 395 (CCPA 1972); *Case v. CPC International, Inc.*, 221 USPQ 196, 201 (Fed. Cir.), *cert. denied*, 224 USPQ 736 (1984).

The aforenoted portions of applicant's specification at page 3, line 34, through page 4, line 4, and page 4, line 7-12, describes a dispersion using only a fluorine-containing surfactant in the amount of not more than 1% by weight on the basis of water, thereby also providing a written description of the

invention that corresponds to Claims 6-11. This description conveys to persons skilled in the art that, as of the filing date of the present application, the inventors had possession of the subject matter set forth in Claims 6-11 as discussed in the aforesaid cases.

In addition, it is respectfully noted that Claims 6-11 do not exclude the nonionic non-flourine-containing surfactant, if it does not adversely effect the presently claimed dispersion. Since these claims do not exclude the non-flourine-containing surfactant, it is not necessary for applicant's specification to describe a dispersion not containing the same. In other words, applicant's claims define the surfactant "consist essentially of" at least one flourine-containing surfactant. Thus, the surfactant can also contain a nonionic non-flourine-containing surfactant, as long as it does not have a deleterious effect on the presently claimed dispersion.

For the foregoing reasons, applicant respectfully submits that the presently claimed invention is supported in the present specification disclosure within the meaning of 35 U.S.C. § 112, first paragraph. Therefore, applicant respectfully request that the Examiner reconsider and withdraw this rejection.

While it is believed that the present response places the application in condition for allowance, should the Examiner have any comments or questions, it is respectfully requested that the undersigned be telephoned at the below listed number to resolve any outstanding issues.

In the event this paper is not timely filed, applicant hereby petitions for an appropriate extension of time. The fee therefor, as well as any other fees which may become due, may be charged to our Deposit Account No. 22-0256.

Respectfully submitted,
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